

Application No. 10/708,928
Amendment dated September 5, 2006
Reply to Office Action of July 5, 2006

Docket No.: 60680-1780

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REMARKS

Applicants have carefully reviewed the Office Action mailed July 5, 2006, **SEP 05 2006** response to the Office Action. Applicants have amended claims 1 and 7, and canceled claims 9 and 20. By way of this amendment, no new matter has been added. Claim 2 was previously cancelled, and claims 13-18 have been withdrawn by the Examiner. Accordingly, claims 1, 3-8, 10-19 and 21 remain pending in this application. At least for the reasons set forth below, Applicants respectfully traverse the foregoing rejections. Further, Applicants believe that there are also reasons other than those set forth below why the pending claims are patentable, and reserves the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers. Applicants respectfully request reconsideration of the present application in view of the above amendment and the following remarks.

Examiner's Reference

The Examiner has provided a reference (NPL Global Spec), contending that the "enclosed reference expressly states that a wave washer 'prevents leakage'." (Final Office Action dated July 5, 2006, page 5) However, the Examiner has confused two distinct sentences, reproduced below:

"**Washers** are disks of metal or non-metallic material placed beneath a nut, an axle bearing, or a joint, to relieve friction, **prevents leakage**, isolate, prevent loosening or distribute pressure." (*emphasis added*)

"Wave washers or *wave springs* are wavy metal washers designed to provide a compensating spring force and sustain a load or absorb shock." (*emphasis added*)

Applicants maintain that wave springs, in and of themselves, are not intended for sealing, and that one of skill in the art would not shuffle the distinct teachings of these two sentences to derive any teaching to the contrary. In further support, Applicants have reproduced another sentence from the Examiner's reference below:

"There are many different types of washers and washer type products for a variety of applications."

Application No. 10/708,928
Amendment dated September 5, 2006
Reply to Office Action of July 5, 2006

Docket No.: 60680-1780

Specification

Applicant has amended paragraphs [0008], [0009], and [0017], in accordance with Examiner's suggestion, to properly identify each Figure.

Claim Rejections – 35 USC § 102

Claims 1, 3-9, 11, 12 and 20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent JP 05180005 to Yoshikawa Mitsuo (hereinafter "Mitsuo"). Applicants respectfully traverse the rejection.

To anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claims 1 and 7, as amended, recite "at least a portion of said retention sleeve selectively extends at least partially into an aperture formed in the first engine component." The Examiner identifies within Mitsuo a 'first engine component' while referring to a flat washer 10d, and a 'retention sleeve' while referring to item 10b in FIG. 7 of Mitsuo. The Examiner also asserts that FIG. 8 of Mitsuo teaches that item 10b "extends at least partially through" the flat washer 10d. In contrast, a close examination of FIG. 8 of Mitsuo reveals that the item 10b has a larger diameter than the hole in the flat washer 10d, and FIG. 8 clearly shows that the item 10b does not extend at least partially through the flat washer 10d. Therefore, the Examiner has failed to establish a *prima facie* case of anticipation by failing to identify all elements of independent claims 1 and 7 in JP 05180005, as required in *Verdegaal Bros.*

Dependent claims 3-6, 8, 11, and 12 teach independently patentable subject matter, although they are also patentable merely by being dependent on an allowable base claim. Applicants further note that the amendments made to independent claims 1 and 7 were taken from canceled claims 9 and 20. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Application No. 10/708,928
Amendment dated September 5, 2006
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Docket No.: 60680-1780

Claims 1, 3, 4, 6-9, 11, 12 and 20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent JP 11050842 to Ando Tokuji. Applicants respectfully traverse the rejection.

Independent claims 1 and 7, as amended, recite “the fastener assembly acoustically decouples the components while generally maintaining a seal therebetween,” and “wherein at least a portion of said retention sleeve selectively extends at least partially into an aperture formed in the first engine component, and wherein at least a portion of said retention sleeve selectively extends at least partially into an aperture formed in the second engine component.” The Examiner identifies items 1, 3b and 5 in JP 11050842 as the ‘first engine component’ and the ‘second engine component.’ However, JP 11050842 teaches item 3b to be a portion of the collar 3, which the Examiner identifies as the ‘retention sleeve’ as recited in independent claims 1 and 7. If the woven wire mesh 5 of JP 11050842 were one of the ‘first engine component’ and the ‘second engine component,’ then one of skill in the art would recognize that the bolt 4 of JP 11050842 would not encourage a seal, since a wire mesh in the exhaust manifold application of JP 11050842 would permit fluids to pass through, thus defeating any seal. Even assuming *arguendo*, that the collar flange 3b of JP 11050842 were to be one of the ‘first engine component’ and the ‘second engine component,’ then one of skill in the art would recognize that the woven wire mesh 5 of JP 11050842, being interposed between the collar flange 3b and the exhaust manifold cover 1 of JP 11050842 would defeat any seal therebetween. Accordingly, the Examiner has failed to establish a *prima facie* case of anticipation by failing to identify all elements of independent claims 1 and 7 in JP 11050842, as required in *Verdegaal Bros.*

Dependent claims 3, 4, 6, 8, 11, and 12 teach independently patentable subject matter, although they are also patentable merely by being dependent on an allowable base claim. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Claim Rejections – 35 USC § 103

Claims 1, 3, 4, 6-9, 11, 12 and 20 were rejected under 35 U.S.C. § 103(a) as obvious over Japanese Patent JP 11050842 to Ando Tokuji. Applicants respectfully traverse the rejection.

Application No. 10/708,928
Amendment dated September 5, 2006
Reply to Office Action of July 5, 2006

Docket No.: 60680-1780

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j).

The remarks presented above with respect to the §102 rejection over Japanese Patent JP 11050842 are equally applicable here. Specifically, the inadequacy of JP 11050842 to teach every element of independent claims 1 and 7 by not teaching "generally maintaining a seal therebetween" is also fatal to the Examiners §103 rejection. Therefore, JP 11050842 does not teach every limitation of independent claims 1 and 7, as required in *In re Royka*.

"The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

JP 11050842 teaches a bolt 4 that couples an exhaust manifold cover 1 and an exhaust manifold 2 to "capable of sufficiently absorbing expansions and contractions caused by heat," that does not seal between the exhaust manifold cover 1 and the exhaust manifold 2. Importantly, JP 11050842 teaches a connection between components where relative movement and separation are desirable, and the woven wire mesh 5, in addition to the gap between the exhaust manifold cover 1 and the collar 3, will provide a leakage path through the connection. Furthermore, one of skill in the art would appreciate that a seal is undesirable between a heat shield and an exhaust manifold, since an exhaust manifold heat shield will desirably permit air to pass between the exhaust manifold cover 1 and the exhaust manifold 2 to allow heat to radiate away from the exhaust manifold 2.

Non-Analogous Art

Furthermore, *In re Oetiker* presents a test for analogous art as "whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor." 24 USPQ2d, at 1445 (Fed. Cir. 1992). "In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must be either in the field of the applicant's endeavor, or, if not, reasonably pertinent to the particular problem with which the inventor was concerned." *Id.* As mentioned above, one of skill in the art would appreciate that a seal is undesirable between a heat shield and an exhaust

Application No. 10/708,928
Amendment dated September 5, 2006
Reply to Office Action of July 5, 2006

Docket No.: 60680-1780

manifold, since an exhaust manifold heat shield will desirably permit air to pass between the exhaust manifold cover 1 and the exhaust manifold 2 to allow heat to radiate away from the exhaust manifold 2. Accordingly, JP 11050842 is not in the field of the applicant's endeavor of acoustically decoupling components "while generally maintaining a seal therebetween," and is therefore non-analogous art.

Dependent claims, 3, 4, 6, 8, 11, and 12 are also patentable by being dependent on an allowable base claim. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

CLAIM 5

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 11050842. Applicant respectfully traverses the rejection.

When rejecting a claim based upon a sole 35 U.S.C. 103(a) reference, the Federal Circuit has provided some guidance. Specifically, *In re Gordon* provides that "[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In addition, the Federal Circuit has held that "[i]t is not pertinent whether the prior art device possesses the functional characteristics of the claimed invention if the reference does not describe or suggest its structure." *In re Mills*, 16 USPQ2d 1430, 1433 (1990).

The remarks presented above with respect to the §102 rejection over Japanese Patent JP 11050842 are equally applicable here. Specifically, the inadequacy of JP 11050842 to teach every element of independent claim 1 by not teaching "generally maintaining a seal therebetween" is also fatal to the Examiners §103 rejection of dependent claim 5. Therefore, JP 11050842 does not teach every limitation of dependent claim 5, as required in *In re Royka*.

CLAIMS 10, 19 AND 21

Claims 10, 19 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 11050842 in view of *Schmidt Jr.* US 5,711,711. Applicant respectfully traverses the rejection.

Application No. 10/708,928
Amendment dated September 5, 2006
Reply to Office Action of July 5, 2006

Docket No.: 60680-1780

The remarks presented above with respect to the §102 rejection over Japanese Patent JP 11050842 are equally applicable here. Specifically, the inadequacy of JP 11050842 to teach every element of independent claims 1 and 7 by not teaching "generally maintaining a seal therebetween" is also fatal to the Examiners §103 rejection of dependent claims 10, 19 and 21. Additionally, Schmidt does not teach these limitations, and therefore, cannot make up for the inadequacy described above. Therefore, the combination of JP 11050842 and Schmidt does not teach every limitation of dependent claims 10, 19 and 21, as required in *In re Royka*.

Claims 10, 19 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 05180005 in view of *Schmidt Jr.* US 5,711,711. Applicant respectfully traverses the rejection.

The remarks presented above with respect to the §102 rejection over Japanese Patent JP 05180005 are equally applicable here. Specifically, the inadequacy of JP 05180005 to teach every element of independent claims 1 and 7 by not teaching "the fastener assembly acoustically decouples the components while generally maintaining a seal therebetween," and "wherein at least a portion of said retention sleeve selectively extends at least partially into an aperture formed in the first engine component, and wherein at least a portion of said retention sleeve selectively extends at least partially into an aperture formed in the second engine component" is also fatal to the Examiners §103 rejection of dependent claims 10, 19 and 21. Additionally, Schmidt does not teach these limitations, and therefore, cannot make up for the inadequacy described above. Therefore, the combination of JP 05180005 and Schmidt does not teach every limitation of dependent claims 10, 19 and 21, as required in *In re Royka*.

Conclusion

In view of the above, each of the presently pending claims in this application is in immediate condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 60680-1780 from which the

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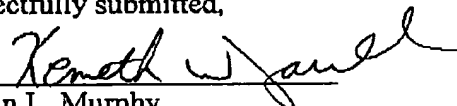
Application No. 10/708,928
Amendment dated September 5, 2006
Reply to Office Action of July 5, 2006

Docket No.: 60680-1780

undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should also be charged to this Deposit Account.

Dated: September 5, 2006

Respectfully submitted,

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